IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: ,
Kathryn G. Rasmussen et al.

Application No.: 10/607,665   Confirmation No.: 8043

Filed: June 27, 2003   Art Unit: 2173

For: SIMPLIFIED IMPLEMENTATION OF   Examiner: D. G. Bonshock
      ADAPTABLE USER INTERFACES

REQUEST FOR A PRE-APPEAL BRIEF CONFERENCE

MS AF   DATE: April 20, 2009
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached five (5) Sheets.

ARGUMENTS

Summary

The subject application is finally rejected (see final rejection of October 21, 2008). Applicants have made numerous attempts to overcome the Examiner's basis for final rejection of the claims to include improper allegations of fact and the application of the rules of practice concerning well-settled case law as applied to 35 U.S.C. § 112, first paragraph et al., and accordingly, a reasonable basis to interpret the claimed invention in view of the applied prior art focusing upon U.S. Patent Publication No. 2003/0056026 A1 to Anuff et al. (hereinafter "Anuff") and U.S. Patent Publication No. 2002/0089546 A1 to Kanevsky et al. (hereinafter "Kanevsky"), and further in view of U.S. Patent Publication No. 2005/0005243 A1 to Olander et al (hereinafter "Olander").

Applicants have attempted to overcome the Examiner's reliance on several mistakes as to fact, law and the construction under the practice rules, and as such, Applicants respectfully assert that the Examiner's numerous actions as set forth in summary herein, and in more complete nature in the prior responses, have amounted to *numerous clear errors* in misconstruing the facts, the supporting law and construction for interpretation under the practice rules.

Applicants respectfully assert that the Examiner has improperly rested upon these numerous errors, and/or improperly inferentially read content from the subject application into the attendant prior art references, and has relied upon these improper bases to maintain the final rejection.

Applicants' Request

Applicants request that a Panel of Examiners formally review the legal and factual bases of the rejection of the above-identified application prior to filing of an Appeal Brief. Applicants assert that the outstanding rejection is improper (now on Appeal by virtue of the concurrently filed Notice of Appeal) based upon the errors in fact, errors in law, and errors for construction under the practice rules.

The October 21, 2008 Final Rejection

The October 21, 2008 final rejection improperly alleges that the subject matter as claimed fails to comply with the statutory requirement of enablement under § 112, first paragraph. Insofar as the Examiner has apparently rested upon a lack of "a definition" of the claimed subject matter in the Specification, the Examiner has clearly misconstrued the statutory basis for reviewing subject matter to determine compliance with § 112, first paragraph.

It is well settled and clearly set forth that a "definition" of the claimed subject matter is not the standard by which construction and compliance under the enablement requirement must be applied during the course of examination.

As set forth in the MPEP § 2164.01 the test for enablement is whether the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.

As stated in MPEP § 2164.01, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement is provided in the Supreme Court decision of *Mineral Separation v. Hyde,* 242 U.S. 261, 270 (1916) which stated that the determination for meeting the enablement requirement is whether experimentation needed to practice the invention undue or unreasonable.

Further, as stated in MPEP § 2164.01 (a), there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

(A) The breadth of the claims;

(B) The nature of the invention;

(C) The state of the prior art;

(D) The level of one of ordinary skill;

(E) The level of predictability in the art;

(F) The amount of direction provided by the inventor;

(G) The existence of working examples; and

(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Applicants respectfully submit that the previous Office Actions fail to address any of the above factors.

Accordingly, Applicants respectfully submit that the prior Office Actions, up to and including the Advisory Action, fail to substantively address any of the above factors, and also clearly rest upon at least one improper basis by which to construe enablement. The Examiner improperly construes support with "a definition" when he compares alleged lack of support with lack of "a definition" by asserting compliance with enablement "where only a formatting of frames according to a CSS is defined". See, for example, the continuation of 11, on page 2 of the Advisory Action dated March 6, 2009.

Applicants respectfully assert that failing to delineate any of the aforementioned factors, which do not comprise an exhaustive list offer clear evidence that the Examiner has so not applied the appropriate standard under § 112, first paragraph, and for that reason the rejection of the pending claims, resting upon § 112, first paragraph must be withdrawn and at a minimum recast in the appropriate fashion as set forth above.

As previously asserted above, and insofar as the Examiner has failed to apply the appropriate standard, Applicants will offer that the written description is sufficiently enabling, as

has been already made of record in the numerous responses to the Office Actions generated in the subject application.

That is to say that the sections stipulated in the Specification, as generally referenced in the prior responses, describe a particular open framework which supports a formatting of the so-called framework may be defined to include cascading style sheets whereby this type of formatting may encompass pre-identified classes that get applied to pre-identified framework containers. See, for example, the remarks section on page 9 of the Amendment filed February 20, 2009. The description from the remarks section goes on to say that this is clearly indicative of a data-level to application-level [event] that is reasonably identifiable on an adaptable user interface. Furthermore, if the Specification as originally filed would be reviewed at this point, clear mention of cascading style sheets (CSS) describe a particular platform for the operation of the particular claimed invention as asserted above. The cascading style sheets, as evidenced in paragraph 9 of the Specification found on page 2, offer one indicative example where the appearance of the website may be quickly, easily and cost-effectively customized for a particular application. Further details of the particular application are described on the following page, which describe a framework, in accordance with an illustrative embodiment of the invention including a plurality of containers that zero or more navigation or content modules may be inserted into. Such a framework may be made up of a combination of containers laid out in such a manner that design flexibility is maximized. Each container may have a unique identifier, and attributes such as height, width, background color and, may be determined separately by attributes of a set of standardized customization mechanisms, which may be defined in a cascading style sheet document.

As such, the varying visual elements that may be quickly customized as delineated on page 2, at the end of paragraph 9, include various placement of a navigational bar, colors, color combinations, graphics, fonts and font size, images, and table styles.

As such, Applicants respectfully assert that the particular description is more than sufficiently clear to one of ordinary skill in the art, and more than sufficiently clear to satisfy the standard under § 112, first paragraph.

Accordingly, Applicants respectfully assert that the rejection of the instant claimed invention under 35 U.S.C. § 112, first paragraph is inappropriate, and furthermore, the Examiner must reissue said rejection as set forth in a *prima facie* case of statutory construction pursuant to the well-settled case law and practice rules as mandated by the U.S. Patent & Trademark Office through appropriate examination.

A second indication of the clear errors made by the current Examiner is indicated by his improper primary combination of Anuff, Olander and Kanevsky, as having alleged that Kanevsky teaches a system for reformatting the graphical user interface (see paragraph 5), but further teaches dynamically sizing the containers that were already created for the display, based on the content inserted into the container such that it would be obvious that a window with no content, would effectively disappear. See, paragraph 10, Kanevsky. However, a close examination of Kanevsky, and a careful review of the claimed invention, would lead one of

ordinary skill in the art to not look to Kanevsky for providing this alleged motivation of disclosure by which to modify Anuff and Olander.

Furthermore, and assuming *in arguendo* that Anuff and Olander may reasonably be combinable as asserted by the Examiner, the Examiner then asserts that Kanevsky would be relied upon to dynamically size the containers that had already been created for display based on the content inserted into the container where it would have been obvious that a window with no content would effectively disappear.

As asserted in the prior responses, the instant claimed invention operates at a data-level, a level well below the application-level, and a level well below and separate from an application that would present anything upon a display interface. That said, the claimed invention is specifically directed to a framework related to a data-level to an application-level relationship. As such, this operates well before and below any actual visually driven application, or top end, which would be presented upon a GUI. Furthermore, the particular focus of the claimed invention is operating on unformatted content with regards to visual characteristics. Clearly, the assertion that the Examiner is relying on to use Kanevsky in his attempt to arrive at the instant claimed invention, operates upon content which is clearly previously formatted, and therefore, would reasonably teach away from Applicants' claimed invention. As such, Applicants respectfully assert that one of ordinary skill in the art having read and understood the claimed invention, would clearly be able to understand that the claimed invention focuses upon content that is unformatted and a framework relating to a data-level to an application-level relationship, that drives and supports the instantiation of the content, accordingly formatting the content and displaying at least a portion of the framework after at least one content module is inserted into the framework. Therefore, Applicants respectfully assert that the assertion of Kanevsky in combination with Anuff and Olander, has failed to meet the burden under *prima facie* case of rejection under § 103. As such, Applicants respectfully assert that the rejection of claims 1-3, 5-13, 15-20, 22, 23 and 26 is improper, and must be withdrawn.

Accordingly, prosecution should be immediately reopened not withstanding any of the other pending issues found herein, and a new non-final Office Action should be promptly forthcoming with the proper construction and appropriately focused rejection under 35 U.S.C. § 112 and § 103.

Insofar as this Pre-Appeal Brief Conference Request fails to move those Panel Examiners to immediately reopen prosecution, Applicants respectfully preserve the right to supplement this Pre-Appeal Conference Request at such time as any other attendant matters to include improper claim construction and/or application of the herein mentioned prior art. Accordingly, Applicants respectfully assert that the Examiner must immediately reopen prosecution, clarify the multiple instances of clear error contained herein, and with prosecution reopened, provide a more precise application of the law and facts to which Applicants may respond to, or issue a Notice of Allowance for the pending claims.
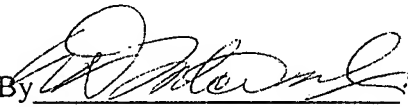
Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact William D. Titcomb (Reg. No. 46,463) at (703) 205-8000 **to schedule a Personal Interview**.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: April 20, 2009   Respectfully submitted,

By _____
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